

REMARKS

In this amendment, Applicant has amended the specification and claim 1 to correct for minor informalities. These corrected informalities include the errors identified by the Examiner in the objection to the Specification. Applicant believes that the application is now in condition for allowance.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-3, 7, and 8 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Keller et al., U.S. 6,182,655 (“Keller”) in view of Dorner, U.S. 6,279,996 (“Dorner”). As admitted in the Office Action, Keller does not disclose a “cap . . . arranged to slide on said strap such that said cap must translate away from said mouthpiece prior to the pivoting of said strap,” as recited in independent claim 1. Instead, the Office Action identifies element 960 of Keller as being the claimed “strap” and element 950 as the claimed “cap.” Keller, however, states that “protective cap 950 consists of the two aforementioned side arms 960 and the actual cap 952.” Keller, col. 8, lines 34-35. As shown in FIGS. 1E and 1F, reproduced herein, the “pair of side arms 960 . . . are fixed on the protective cap 950 and engage in a longitudinally displaceable manner in the inside of the inhaler.” Keller, col. 7, lines 62-64. The side arms 960 of Keller are shaped to interact with remainder of the lower part 100 such “that the protective cap 950 can only be swung down when it has been pulled out to the limit.” Keller, col. 8, lines 20-22. Accordingly, the Examiner correctly realizes that the protective cap 950 does not “slide on” either side arm 960 of Keller.

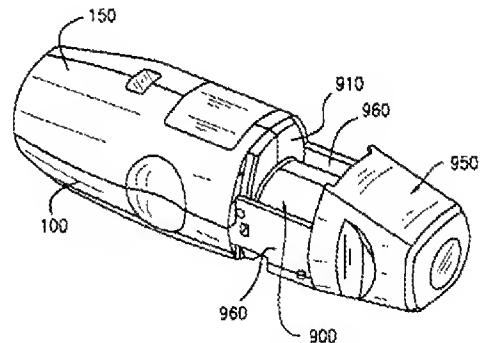


FIG. 1E

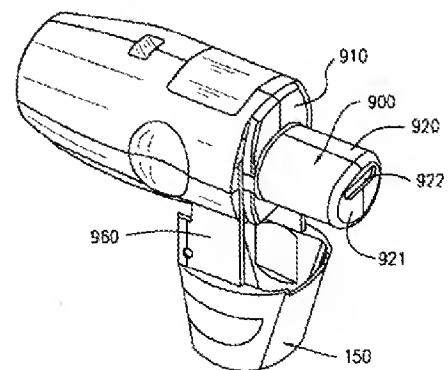


FIG. 1F

The Office Action, however, alleges that it would have been obvious to modify Keller's device such that the cap 950 slides on the side arms 960 based on the disclosure of Dorner. Applicant disagrees. Modifying Keller such that the cap slides on the side arms, rather than having the cap slide with the side arms, would undermine Keller's function of having the side arms prevent rotational movement of the cap relative to the main body (lower part 100) unless the cap has been swung out to the limit. Rotational movement of the cap 950 of Keller can only be achieved based on the position of the side arms 960 relative to portions of the lower part 100. Moreover, modifying Keller such that the side arms are fixedly attached to the lower part 100 and that the cap pivots relative to the side arms would interfere with user access to the mouth piece due to the presence of the side arms. Accordingly, one having ordinary skill in the art would not modify the device of Keller as alleged in the Office Action because one having ordinary skill in the art at the time of invention would recognize that such a modification would undermine the function of the side arms of Keller to allow for rotational movement between the lower part and the cap only once the cap has been pulled out to the limit.

The specific disclosure of Dorner also would not give one having ordinary skill in the art reason to modify Keller in a way that would undermine the purpose of Keller, as asserted in the Office action. Dorner discloses a sanitary container (e.g., a trash can) that includes a cover guide and holder C that prevents "mischievous children" and animals from running away with the lid. There is no structure in Dorner that prevents the cover guide and holder C from pivoting until the lid B is moved to the maximum height. Nor is there any other feature of the arrangement of Dorner that suggest usefulness for a cap for the device of Keller. The cap of Keller already has retaining and pivoting functions disclosed by Dorner, but also has the additional function of preventing rotation unless the cap is pulled out to the limit. Accordingly, one having ordinary skill in the art would not have any reason to modify Keller based on the disclosure of Dorner.

Moreover, one having ordinary skill in the art also would not consider the disclosure of prior art directed to trash cans when seeking to design an inhaler for administering medicament. Each cited reference must meet a two-step test to determine if it is analogous art and therefore properly asserted in an obviousness rejection.

The first step is to determine whether the reference is “within the field of the inventor’s endeavor”.¹ If not, the reference may still be pertinent if it is “reasonably pertinent to the particular problem with which the inventor was involved.”² The inventors define the field of endeavor, such as by their specification and claims.³ In this case, the specification begins: “The present invention relates to an inhaler for administering medicament by inhalation . . .”⁴ The claims in issue all begin their preambles: “An inhaler for dispensing doses of medicament from a container under user activation.”

Moreover, Dorner also fails the second test, to which the Examiner has made no comment, because it is not a prior art reference which, “because of the matter with which it deals, would have commended itself to an inventor’s attention in considering his problem.”⁵ It is improper to define the “problem” broadly, in hindsight, in order to legitimize an improper reference citation.⁶ A reference directed to a different purpose than the invention would have provided less motivation or occasion to an inventor to have considered it.⁷

Accordingly, the rejection is of claims 1-3, 7, and 8 over Keller in view of Dorner is improper and must be withdrawn.

The rejection of dependent claim 8 is further improper because Keller fails to disclose a cap that is attached to a strap by means of a lug. The Office Action alleges that element 962 of Keller is the lug. Element 962, however, is a pin about which the arm is pivotably connected to the main body (lower part 100). The Keller cap 952 is integrally formed with the side arms 960 and thus are not attached thereto by a lug. Accordingly, the rejection of dependent claim 8 over Keller in view of Dorner is in error for this additional reason.

¹ In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986).

² Id.

³ In re Clay, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992).

⁴ Specification, p. 1, line 6.

⁵ In re Clay, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992).

⁶ To illustrate an example of an improperly broad problem formulation, in *In re Clay* the CAFC found that the patentee's field of endeavor was the “storage of refined liquid hydrocarbons,” a field that tracks the claim preamble fairly well. They rejected as clearly erroneous the Examiner's and Board's broader statement of the field as “maximizing withdrawal of petroleum stored in petroleum reservoirs,” a characterization that would have included the cited reference that dealt with in-ground storage of unrefined petroleum.

⁷ Id.

Dependent claim 4 stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Keller in view of Dorner in further view of Beck et al., U.S. 4,848,612 (“Beck”). Dependent claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Keller in view of Dorner in further view of Casper et al., U.S. 6,357,442 (“Casper”). These rejections are improper for the same reason as discussed above. Neither Beck nor Casper provides any disclosure that would give a person having ordinary skill in the art to reason modify Keller such that the cap slides on the side arms, as alleged in the Office Action. Accordingly, Applicant asks that these rejections also be withdrawn.

CONCLUSIONS

Accordingly, each of the pending claims 1-8 defines patentable subject matter over the cited prior art. Furthermore, each of the pending claims is believed to be in form for allowance. As such, Applicants request that the Examiner allow pending claims 1-8.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue, or comment does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper.

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Serial No. : 10/579,481
Filed : April 27, 2007
Page : 10 of 10

Attorney's Docket No.: 06275-0509US1 / 101087-1P
US

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date:October 26, 2009

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